

REMARKS

Claims remaining in the present application are Claims 1-21. Claims 1, 10, and 13 have been amended. No new matter has been added as a result of these amendments.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Muta, Nagai, and Zelinsky

Claims 1-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Muta et al., U.S. Pat. No. 6,448,958 (hereinafter, Muta) in view of Nagai U.S. Pat. No. 5,483,631 (hereinafter, Nagai), in further view of Zelinsky, et al., U.S. Pat. No. 4,837,710 (hereinafter, Zelinsky). The rejection is respectfully traversed for the following reasons.

CLAIM 1

Amended Claim 1 recites, in part:

- b) an application program of said computer system making a call to request a display attribute for an object to be displayed on said display screen;
- c) in response to said request, indexing a table with said flag and an object identifier to obtain a display attribute, wherein said object identifier identifies said object, and wherein said table is located in said computer system externally of said application program and comprises a list of said object identifiers and a plurality of display attribute lists, each of said display attribute lists having a display attribute associated with each of said object identifiers, wherein at least two of said display attribute lists correspond to different potential display capabilities of said display screen.

Muta incompatible with Nagai and Zelinsky

Applicants first respectfully assert that Muta is incompatible with Nagai and Zelinsky. Even if, for the sake of argument, Muta would be combined with Nagai and/or Zelinsky the combination would not be the embodiment that Applicants have Claimed in Claim 1. Muta teaches a technique that allows a computer system with very limited processing ability to be able to display objects that were designed to be displayed on a computer system with far more processing power. The computer

system with the limited processing capability (215) must send information to the computing system with more processing power (e.g., supporting server 247), which sends back a rendering instruction. Thus, the nature of Muta's invention requires two separate computer systems. Moreover, any attempt to combine Nagai and/or Zelinsky to arrive at the claimed invention would appear to require incorporating teachings of Nagai and/or Zelinsky into Muta's supporting server (247), as that is where Zelinsky determines what should be rendered on the computer system with limited processing ability. Thus, even if for the sake of argument the teachings of Nagai and/or Zelinsky were to be combined with Muta, the combination cannot be what Applicants have claimed in Claim 1, as Claim 1 recites limitations that the application program and the table are both on the same computer system.

Because Muta is not combinable with Nagai and/or Zelinsky, according to Applicant's understanding, only Nagai and Zelinsky are left to combine under this 35 U.S.C. §103 rejection. Applicants further assert that even if teachings of Nagai and Zelinsky were to be combined, the limitations of Claim 1 would not be arrived at. At a minimum this is because the combination of Nagai and Helsinki fails to teach or suggest, "an application program of said computer system making a call to request a display attribute for an object to be displayed on said display screen," as claimed. For the foregoing reasons, Claim 1 is respectfully believed to be patentable over Muta, Nagai and Zelinsky.

Impermissible Hindsight Analysis

Applicants argue that the instant rejection engages in impermissible hindsight analysis. Thus, even if Muta is assumed to be combinable with Nagai and Zelinsky, the cited combination of Muta, Nagai, and Zelinsky fails to teach or suggest the claimed, "table ... located externally of said application program and compris[ing] a

list of said object identifiers and a plurality of display attribute lists, each of said display attribute lists having a display attribute associated with each of said object identifiers, wherein at least two of said display attribute lists correspond to display capabilities of said display screen." The Federal Circuit has warned against the impermissible use of hindsight in a 35 U.S.C. §103 analysis.

Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the tempting but forbidden zone of hindsight...when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field....Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher (*In re Dembicza*k, 50 USPQ 2d 1614, 1616-17 (Fed. Cir. 1999, emphasis added).

The rejection essentially asserts that one of ordinary skill in the art, in theory, could have thought to combine Zelinsky's teaching of a table having a conversion between monochrome display attributes to color attributes with Nagai's teaching of a table having display objects and display attributes with Muta's teaching of a rendering engine, while modifying Muta's teaching by including a display mode flag that is used to index the table. The

Applicants respectfully assert that the rejection is impermissibly using the Applicant's Claim 1 as a blueprint to piece together pieces of prior art to arrive at the claimed invention.

With respect to the Zelinsky reference, which the rejection uses as teaching the limitation of "display attribute lists correspond to different [potential display] capabilities of said display screen," the rejection essentially asserts the motivation to combine Zelinsky with Nagai and Muta would have been "to effectively provide proper display attribute corresponding to the display device's type." Applicants respectfully submit that the rejection essentially argues that combining Zelinsky with Nagai and Muta results in a better design. However, it is the Applicant's Claim 1 that teaches this improvement. Applicants respectfully assert that the rejection is engaging in hindsight reasoning and using what the Applicant as taught in the claims as a blueprint.

For the foregoing rationale, one of ordinary skill in the art would not have been motivated to combine the references to arrive at the embodiment recited in Claim 1. Moreover, for reasons previously discussed, Applicants respectfully assert that Muta is not combinable with Nagai and/or Zelinsky. Therefore, is respectfully asserted that independent Claim 1 is not unpatentable over the cited combination of Muta, Nagai and Zelinsky.

Muta, Rhyne, and Zelinsky

Claims 1-21 are also rejected under 35 U.S.C. §103(a) as being unpatentable over Muta in view of Rhyne U.S. Pat. No. 4,521,770 (hereinafter Rhyne), in further view of Zelinsky. The rejection is respectfully traversed for the following reasons.

Muta Incompatible with Rhyne and Zelinsky

For reasons discussed herein, there is no suggestion in the references to combine Muta with Rhyne and/or Zelinsky to arrive at the embodiment of the

Applicants invention recited in Claim 1. Moreover, any attempt to combine Rhyne and/or Zelinsky to arrive at the claimed invention would appear to require to incorporate teachings of Rhyne and/or Zelinsky into Muta's supporting server (247), as that is where Zelinsky determines what should be rendered on the computer system with limited processing ability. Thus, even if for the sake of argument the teachings of Rhyne and/or Zelinsky were to be combined with Muta, the combination cannot be what Applicants have claimed in Claim 1, as Claim 1 recites limitations that the application program and the table are both on the same computer system.

Because Muta is incompatible with Rhyne and/or Zelinsky, according to Applicant's understanding, only Rhyne and Zelinsky are left to combine under this 35 U.S.C. §103 rejection. Applicants further assert that even if teachings of Rhyne and Zelinsky were to be combined, the limitations of Claim 1 would not be arrived at. At a minimum this is because the combination of Rhyne and Zelinsky fail to teach or suggest, "indexing a table with said flag and an object identifier to obtain a display attribute," as claimed.

For the foregoing reasons, Claim 1 is respectfully believed to be patentable over Muta, Rhyne and Zelinsky. For reasons discussed above, Claim 1 is respectfully believed to be patentable over Muta, Nagai, and Zelinsky. Therefore, it is respectfully asserted that independent Claim 1 overcomes the references cited of record and is therefore allowable.

Claims 10 and 13

Currently amended Claims 10 and 13 contain similar limitations as Claim 1. For the reasons discussed in the response to Claim 1, it is respectfully asserted that

independent Claims 10 and 13 overcome the references cited of record and are therefore allowable.

Claims 2, 3, 6 - 9, 11 - 12, and 14 - 21 depend from Claims 1, 10, and 13, which are believed to be allowable. As such, it is respectfully asserted that the rejection of Claims 2, 3, 6 - 9, 11 - 12, and 14 - 21 has been overcome.

CONCLUSION

In light of the above listed remarks, reconsideration of the rejected Claims is requested. Based on the arguments presented above, it is respectfully submitted that Claims 1-21 overcome the rejections of record. Therefore, allowance of Claims 1-21 is earnestly solicited.

Should the Examiner have a question regarding the instant response, the Applicants invite the Examiner to contact the Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,
WAGNER, MURABITO & HAO LLP

Dated: 3/11, 2004


Ronald M. Pomerenke
Registration No. 43,009

Address: WAGNER, MURABITO & HAO LLP
Two North Market Street
Third Floor

Telephone: San Jose, California 95113
(408) 938-9060 Voice
(408) 938-9069 Facsimile